

REMARKS-General

1. The newly amended independent claim 31 incorporates all structural limitations of the originally presented claim 31 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All claims 31-34 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

2. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Regarding the Rejections of Claims 31-34 under 35USC102

3. The examiner rejects claims 31-34 under 35USC102(b) as being anticipated by Skwirut et al (US 4,300,073). Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

4. In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her invention was patent in this country more than one year prior to the date of the application for patent in the United States.

5. However, Skwirute et al. patent and the instant invention are not the same invention according to the fact that the disclosure of Skwirute et al. patent does not read upon the instant invention and the newly amended independent claim 31 of the instant invention does not read upon Skwirute et al. patent too.

6. The applicant respectfully clarifies the differences between the instant invention and Skwirute et al. for the purpose of overcoming the rejection under 35USC102(b) as follows:

(A) Regarding the newly amended independent claim 31, Skwirut et al. fails to anticipate an illuminable unit comprising a light tube having a spirally-shaped light body and two end portions **downwardly, inclinedly and integrally** extended therefrom **in a predetermined and curved manner**, wherein the two end portions of the light tube are parallelly extended from the light body in the above mentioned predetermined manner, a conductor enclosure, and a conductor wire having a first section electrically extended from the cathode terminal along the spirally-shaped light body to the conductor enclosure at the corresponding end portion of the light tube, and a second section extended along the conductor enclosure for electrifying the mercury source, wherein the second section of the conductor wire is arranged to extend along a longitudinal **and inclined** direction of the corresponding end portion of the light tube within the conductor enclosure, in such a manner that an overall length of the conductor wire is maximized within a confined space of the light tube and the conductor enclosure, while **minimizing an overall vertical length** of the end portion of the light tube, so that the light tube is capable of effectively and efficiently generating illumination while keeping the light tube and the conductor enclosure compact.

(B) In Skwirut et al., the legs (24, 26) are vertically extended from the U-bent segments (29) so that the stem components (33, 34) and the electrodes (35, 36) are also vertically extended within the legs (24, 26) (Skwirut et al., Fig. 1). In other words, the overall size of the lighting unit disclosed in Skwirut et al. is bulky having a significant height. The drawback for this construction is that any light cover designed to mount around the lighting unit disclosed in Skwirut et al. must have a height greater than that of the lighting unit, rendering the entire lighting system (the lighting unit and the light cover) bulky in size and difficult to set up and disassemble.

(C) Regarding claim 33, Skwirut et al. fails to anticipate that the mercury source is amalgam contained in said light tube, in addition to what is claimed in the newly amended independent claim 31 as a whole.

Response to Rejection of Claim 32 under 35USC103

7. The Examiner rejected claim 32 as being unpatentable over Skwirut et al. in view of Ge et al. (US 6,515,433). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

8. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

9. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Skwirut et al. which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Ge et al. at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

10. The applicant respectfully submits that the differences between the instant invention and Skwirut et al. is not obvious in view of Ge et al. under 35USC103(a), due to the following reasons:

(D) Regarding claim 32, Skwirut et al. fails to anticipate that the mercury source is liquid mercury contained in said light tube, in addition to what is claimed in the newly amended independent claim 31 as a whole.

(E) The Examiner appears to reason that since Ge et al. teaches that liquid mercury can be used for a gas discharge fluorescent device, it would have been obvious to one skilled in the art to modify Skwirut et al. with the teaching in Ge et al. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the

modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In the present case, there is no such suggestion.

(F) In any case, even combining Skwirut et al. and Ge et al. would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). The differences between the instant invention and Skwirut et al. have fully been delineated in Paragraphs (A) to (B) above.

10. Applicant believes that for all of the foregoing reasons, all of the claims 31-33 are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

11. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

12. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 31-33 at an early date is solicited.

13. Should the examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

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Person Signing: Raymond Y. Chan